

REMARKS

Applicants have carefully considered the Examiner's comments set forth in the Office Action of April 01, 2008. Reconsideration of the Application is requested in view of the amendments and comments herein. Claims 1-6, 8-9 and 19-23 are currently pending. Claims 19, 20 and 21 have been amended.

I. The Office Action

Claim 19 is objected to because the claim amendment in lines 15-16 recites a limitation that is already recited in lines 10-11.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-6, 8-9 and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/07902(WO'902).

Claims 1-6, 8-9 and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oshima et al. (U.S. 6,719,852), in view of WO 02/07902.

II. Claim Objection

Claim 19 is objected to because the claim amendment in lines 15-16 recites a limitation that is already recited in lines 10-11. Claim 19 has been amended to remove the duplicate claim limitation. Therefore, the objection should be withdrawn.

III. Rejection of Claim 20 Under 35 U.S.C. 112, Second Paragraph

Claim 20 stands rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. According to the Examiner, the recitation of "the organic chelate" in line 12 lacks sufficient antecedent basis for the limitation in the claim. Claim 20 has been amended to recite, "...wherein an organic chelate is present in a concentration of from about 0.02M to about 0.3M." Applicant asserts that claim 20 is now in condition for allowance; therefore the rejection should be withdrawn.

IV. Rejection of Claims 1-6, 8-9 and 19-23 Under 35 U.S.C. 103(a) as Being Unpatentable over WO'902

Claims 1-6, 8-9 and 19-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO'902. It is respectfully requested that the rejections be withdrawn for at least the following reason. WO'902 does not teach or make obvious independent claims 1, 19 or 20 (along with claims 2-6, 8-9 and 21-23 that depend therefrom).

Applicant is unclear as to precisely which references the Examiner is using in this rejection. In paragraph 8 (Office Action 4-01-08), the Examiner states that the rejection is based on WO'902. However, on page 4, the Examiner refers to the Huvar patent. Applicant has responded on the belief that the Examiner is rejecting the claims over WO'902 in view of Huvar (U.S. 4,349,392).

The Examiner sets forth two allegations of obviousness. First, the Examiner states the one or more citric acid, tartaric acid and malonic acid as taught by WO'902 read on the claimed chelate; the nitrate and sulfate ions from the nitric or sulfuric acid used for pH control as taught by WO'902 read on the claimed sulfate and/or nitrate ions; and the iron, cobalt and nickel ions as taught by WO'902 read on the claimed transition metal or metalloid. Further, according to the Examiner, the component concentrations of Cr(III) ions, phosphorous anions, Fe/Co/Ni ions, the pH value ranges and the Cr (III) to Fe/Co/Ni ratio range (i.e. as calculated from the concentrations of Cr (III) ions and Fe/Co/Ni ions) in the coating solution of WO'902 overlap the claimed component concentration ranges, the claimed pH value range and the claimed Cr(III) to transitional metal or metalloid range. Applicant respectfully disagrees.

The standard for determining *prima facie* obviousness was stated in *In re Lintner* (1972): "In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination or other modification." Here, the *prima facie* case would be insufficient because WO'902 fails to teach or suggest either the chelate concentration range or the claimed sulfate and/or nitrate ion concentrations as recited in independent claims 1, 19 and 20. Therefore, no such *prima facie* obviousness case has been established.

For the second case for *prima facie* obviousness, the Examiner reasons that although WO'902 does not teach the claimed chelate or nitrate and/or sulfate concentration ranges, the sulfate and carboxylic acid concentration ranges as taught by WO'902 in view of Huvar overlap the claimed sulfate and chelate concentration ranges recited in claims 1, 19 and 20. The Examiner reasons that it would have been obvious to one skilled in the art to select the claimed sulfate and chelate concentration ranges from the disclosed sulfate and carboxylic acid concentration ranges of WO'902 in view of Huvar, since WO'902 in view of Huvar teach the same utilities in their disclosed sulfate and carboxylic acid concentration ranges. Applicant respectfully disagrees.

Particularly, Huver implements the particular concentration of carboxylic acids or salt thereof to increase the clarity and initial hardness to the gelatinous film deposited. One of ordinary skill in the art would not be motivated to look to the teachings of Huver to achieve greater clarity of a black coating, since by nature, black coatings are not meant to be clear. Therefore, the Examiner is using Applicant's invention as a template through hindsight reconstruction. Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning as to why one skilled in the art would look to a particular combination of references to solve a specific problem. In this instance, the Examiner's statement that it would have been obvious to look to the Huver references to optimize the clarity of black coating is purely conclusory.

Moreover, the Examiner argues that since the carboxylic acids taught by WO'902 are result effective variables used to complex the Cr (III) ions and to regulate to chrome (III) hydroxide precipitate on the metal surface, it would be obvious to one skilled in the art to vary the concentration via routine optimization. Similarly, the Examiner argues that one with ordinary skill in the art would have found it obvious to have varied the amount of sulfate and nitrate ions in the coating solution of WO'902 via routine optimization in order to achieve desired pH. However, "...obvious to try is not the standard of 35 U.S.C. 103...[d]isregard for the unobviousness of the results of 'obvious to try' experiments disregards the 'invention as a whole' concept of §103,...and overemphasis on the routine nature of the data gathering required to arrive at appellant's discovery, after its existence became expected, overlooks the last sentence

of §103. *In re Antonie*, 559 F.2d 618 (CCPA 1977). Further, the Federal Circuit held, “a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection.” *In re Rijckaert*; 9 F.3d 1531 (Fed. Cir. 1993). As is the case here, the court reasoned that while a condition described may be an optimal one, it is not necessarily inherent in the primary reference.

With regard to claim 21, the Examiner’s rejection is now moot in light of the current amendment. Claim 21 has been amended to recite “...wherein the phosphorous anions consist of phosphate anions.” Therefore, it no longer includes any additional elements.

V. Rejection of Claims 1-6, 8-9 and 19-23 Under 35 U.S.C. 103(a) as Being Unpatentable over Oshima et al., in view of WO’902.

Claims 1-6, 8-9 and 19-23 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Oshima et al., in view of WO’902. Applicant respectfully traverses the rejection for at least the following reason. Oshima, in view of WO’902, does not, individually or in combination, teach or suggest each element of independent claims 1, 19 and 20 (or claims 2-6, 8-9 and 21-23 that depend therefrom).

According to the Examiner, it would have been obvious to one of ordinary skill in the art to have incorporated cobalt, nickel and/or iron in a concentration of 0.001-0.1 mol/l each and black pigments such as carbon black in an amount of 5-20g/l, as taught by WO’902, in the coating solution of Oshima in order to produce a black chromate coating. Applicant respectfully disagrees. Oshima (examples 1 and 2) shows cobalt concentrations 0.2g/l and 0.5g/l respectively; however the color of the coating was a pale blue. The Examiner disregards this clear teaching away with the argument that the formation of a black conversion as taught by WO’902 is a result of a combination of multiple coating components in suitable ranges, such as phosphates, black pigments, cobalt, iron and/or nickel. Therefore, a person with ordinary skill in the art is to add the WO’902 components to the Oshima coating solution and vary the concentrations of these components to achieve the desired black colored coating. As discussed above, the Examiner’s assertion is an improper use of hindsight to produce the subject invention. WO’902 does not indicate which combinations of such components and in

what precise concentrations produce the black color; therefore, in order to achieve such result in Oshima, one skilled in the art would be required to perform undue and timely experimentation. Achieving the black color coating is not inherent in the combination because it requires an additional step. As such, there is no basis presented that the presently claimed invention would be achieved by such a combination.

For at least the aforementioned reasons, Oshima in view of WO'902 does not make the present invention unpatentable. Applicants respectfully request withdrawal of the rejection of claims 1-6, 8-9 and 19-23.

CONCLUSION

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 1-6, 8-9 and 19-23) are in condition for allowance.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call Scott McCollister, at Telephone Number (216) 861-5582.

Respectfully submitted,

FAY SHARPE LLP



Scott A. McCollister, Reg. No. 33,961
1100 Superior Avenue, Seventh Floor
Cleveland, OH 44114-2579
216-861-5582

August 29, 2008

Date

Certificate of Electronic Transmission

I hereby certify that this Amendment and accompanying documents are being filed on the date indicated below by electronic transmission with the United States Patent and Trademark Office via the electronic filing system (EFS-Web).

August 29, 2008

Date



Georgeen B. Sonntag

N:\PVOZ\200015\kat0000120V001.docx